IAU/2187

PATENT
P56369

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

EUNG-SUN CHUN

Serial No.: 09/839,152 Examiner: MCLEAN MAYO, KIMBERLY N.

Filed: 23 April 2001 Art Unit: 2187

For: ALARM MANAGEMENT SYSTEM AND METHOD THEREOF FOR NETWORK MANAGEMENT SYSTEM

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the first Office action mailed on 5 October 2004 (Paper No. 20040929), entry and consideration of the following timely filed petition is respectfully requested.

Folio: P56369
Date: 10/18/04
I.D.: REB/kf

STATEMENT OF FACTS

1. On 5 October 2004, the Examiner mailed an Office action (Paper No. 20040929). Paper No. 20040929 mentioned that the Examiner required labeling of Figure 1 as "prior art".

2. Three copies of Decisions on Petition for the following references previously issued by Group Directors to reverse similar requirements by other Examiners to label drawings as "prior art", are enclosed:

   - Paper No. 21 issued on 25 February 1998 for U.S. Application SN. 08/447,279 filed on 22 May 1995;
   - Paper No. 15 issued on 2 October 1996 for U.S. Application SN. 08/343,939 filed on 17 November 1994; and
   - Paper No. (unknown) issued on 15 December 1999 for U.S. Application SN. 08/985,544 filed on 5 December 1997.

REMARKS

In Paper No. 20040929, the Examiner erroneously maintained the objection on Figure 1 to be labeled as "prior art." The Examiner states:

> "Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated."

MPEP §608.02(g) states:

> "Figures showing the prior art are usually unnecessary and should be canceled. Ex parte Elliott, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."
>
> If the prior art figure is not labeled, form paragraph 6.36.01 may be used.
>
> ¶ 6.36.01 Illustration of "Prior Art"
> Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP §608.02(g)."

Applicant has explained that Figure 1 is not "prior art".

First, in Paper No. 20040929, the Office action mailed 5 October 2004, the Examiner asserted that "Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated" and cited section 608.02(g) of the *Manual Patent Examining Procedure*. The term "Prior Art" is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term "Prior Art" by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102 however, states that subject matter "which is ***old***" constitutes prior art, as asserted by the Examiner on page 2 of the Office action, Paper No. 20040929. In short, the age of the subject matter does not convert that subject matter into prior art, as the term "prior art" is defined by the law of the United States. Consequently, the Examiner's sole rational for imposing the requirement that Figure 1 be labeled as "prior art" is contrary to statute and improper. The requirement must be therefore be withdrawn.

Second, Figure 1 is not itself believed to constitute "prior art" as that term is defined by either 35 USC §102 or 35 USC §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant's belief or establish that Figure 1 constituted *prior art*, as that term is defined by statute. As evidenced from the Declaration/Oath, the Applicant is a citizen of Korea, and, as such, devised Figure 1 in Korea in order to illustrate Applicant's discovery of problems plagued in the art. Therefore, since there is no showing that Figure 1 was known to anyone other than the Applicant *in this country* nor is there a showing that Figure 1 was *patented or published in this country or a foreign country*, then Figure 1 can not be deemed to be "prior art" absent evidence to the contrary.

Third, Figure 1 is simply abstract representation of the art prepared by the Applicant in an effort to illustrate Applicant's discovery of problems plagued in the art in accordance with 37 CFR §1.83(b); this discovery is itself, together with Appellant's abstraction of the art represented by Figure 1, part of the Applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "prior art" as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g).

Finally, it should be noted that Applicant has never made any statement admitting that Figure 1 was "prior art".

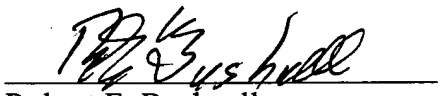
REMEDY REQUESTED

In view of the above, the Commissioner is respectfully requested to:

A. Withdraw the requirement for labeling of Figure 1 as "prior art";

B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231

Paper No. 21

Robert E. Bushnell
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In re Application of
Gwon-Il Kim
Application Serial No.
08/447,279
Filed: May 22, 1995
For: SERVO CONTROLLER APPARATUS AND METHOD OF DISK RECORDING SYSTEM

DECISION ON RENEWED PETITION UNDER 37 C.F.R. § 1.181

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya , 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

Gerald Goldberg, Director
Technology Center 2700-
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T5316

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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#15

In re Application of :
MYUNG-CHAN JEONG :
Serial No: 08/343,939 :
Filed on : November 17,1994 :
For : DIGITAL SERVO CONTROL :
APPARATUS AND METHOD :
OF DATA STORAGE SYSTEM :
USING DISK RECORDING :
MEDIA :

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996 requesting the withdrawal of the requirement to label Fig. 3 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally filed and discussed was referred to as "CONVENTIONAL". Hence, in keeping with the disclosure and petitioner's arguments, the examiners' requirement to label this figure as "Prior Art" is incorrect and withdrawn.

Summary: The petition is Granted.

Jin F. Ng, Deputy Director
Examining Group 2500
Electrical and Optical Systems
and Devices

JFN/AMP

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Group 3600

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WASHINGTON, D.C. 20005-1202

In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT DISPLAY DEVICE

P54947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is **GRANTED**.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues. 1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

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